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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,285	06/26/2000	Vincent James Gatto	PM 268477	5162

7590 12/04/2001  
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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/04/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/604,285

Applicant(s)

GATTO et al

Examiner

MEDLEY

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 22-54 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 22-54 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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The request filed on June 26, 2000 and perfected on December 12, 2000 for a Reissue Application 09/604,285 under 37 CFR 1.175 (a) (1) based on Letter Patent RE37,363 E, issued on September 11, 2001 from Application Serial No. 09/359,770 filed on July 22, 1999 which is based on Letter Patent 5,650,381, issued on July 22, 1997 from the original application, Serial Number 08/559,879 filed on November 20, 1995 is acceptable and a Reissue Application 09/604,285 has been established. An action on the Reissue Application follows:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 22-40 and 42-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorsell et al 4,648,985 combined with applicants' admission in view of Louis de Vries et al 4,394,279.

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Applicants claim a method for improving the antioxidant and friction properties of a lubricant comprising adding to the lubricant a Mo compound and an oil soluble secondary diarylamine (claim 52); a method for lubricating a crankcase or transmission comprising lubricating a crankcase or transmission with a lubricating composition (claim 53) according to claims 22 or 23; a lubricated crankcase or transmission obtained according to claim 53 (claim 54); and lubricant compositions comprising a lubricating oil, a Mo compound, and a secondary diarylamine and further comprising conventional additives in the lubricating oil composition (claims 22-51).

Thorsell et al teach and discloses a lubricant composition comprising a dithiocarbamate and a phosphate and a molybdenum carboxylate with the further inclusion of conventional additives e.g. an amine oxidant, note column 4 lines 27 to column 5 lines 1-29 and 54 to column 6 lines 1-11 and column 9, lines 30-39. The Thorsell et al further disclose amine oxidation inhibitors in its lubricant composition, note column 9, lines 33-34. Patentees further disclose the use of its lubricant composition in enclosed and open gear lubricant system, bearing greases and cam lubricants which encompass Applicants claimed method for lubricating a crankcase or transmission and lubricated crankcase or transmission, note column 11, lines 46 to 51 and column 8, lines 60 to column 9, lines 1-23. Thorsell et al further disclose process steps for adding to a lubricant oil a Mo compound and a secondary diarylamine which inherently would improve the oxidation and friction properties of a lubricant composition, note column 8, lines 60-65 and column 9, lines 30-34. Applicants make admission on record at column 3 line 56 to column 4

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lines 1 to end of the instant application that the prior art teaches well-known molybdenum compounds which are substantially free of phosphorus and active sulfur which are conventionally used as lubricant additives in lubricant compositions for their known anti-friction and anti-oxidant properties. Applicants' admission on record provides the motivation to one of ordinary skill in the art to substitute the admitted prior art well-known molybdenum compounds for the molybdenum compounds of Thorsell.

Applicants' instant claim compositions, methods for improving the antioxidant and friction properties, method for lubricating a crankcase or transmission and lubricated crankcase or transmission are specific to a secondary diarylamine antioxidant and of a specific structure (claims 45-50) and of specific relative proportion of the diarylamine wherein the prior art is silent to said specifics. It is the Examiner's position that the inclusion of an amine of a secondary diarylamine structure in relative proportion of about 750 to 5,000 ppm in the lubricant oil composition would be obvious in view of Louis de Vries et al.

The secondary reference, Louis de Vries et al, discloses 0.05 to 15 % by weight (500-150,000 ppm) sulfur free containing molybdenum complexes in combination with 0.02 to 10 parts by wt. of an aromatic amine in a lubricant (abstract, col. 1 line 53 to col. 2 lines 1-3, and col. 5, lines 1-19) and provides for the preparation of concentrates of the combination of additives within a carrier liquid to provide a convenient method of handling and transporting the additives (col. 8, lines 35-42).

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It would have been obvious to the person having ordinary skill in the art at the time of the invention to use the secondary amine compounds of Louis de Vries et al as the amine in Thorsell et al lubricant, concentrate, methods and lubricated crankcase or transmission to arrive at a lubricant having improved antioxidant and friction properties and a molybdenum compound which is substantially free of phosphorus and active sulfur because combining two or more materials disclosed by the prior art for the same purpose to form a third material that is to be used for the same purpose has been held to be a prima facie case of obviousness, See In re Kerkhoven, 205 USPQ 1069. The ratios of the Mo compound to the diarylamine compound can be determined by routine experimentation as disclosed by Thorsell et al, note column 9, lines 24-26.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thorsell et al 4,648,985 combined with Applicants' admission in view of Louis de Vries et al 4,394,279 as applied to claims 22-40 and 42-51 above, and further in view of Hunt et al 4,832,857.

The difference between the references applied above and the instant claim(s) is:

The molybdenum complex produced by a reaction is not disclosed by the above relied on prior art.

However, Hunt et al at column 4, lines 41 to col. 5, lines 1-5 teach that the process is old and conventional and that the reaction product is commercially acceptable for use in lubricating oil compositions.

It would have been obvious to one of ordinary skill in the art to modify the above references' teachings further as taught by Hunt et al. in the molybdenum compound is phosphorus

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and sulfur free and Thorsell would arrive at a lubricant having improved antioxidant and friction properties.

It is further noted that the process limitations of claim 41 cannot impart patentability to a product which is not patentably distinguished over the prior art. In re Thorpe et al (CAFC 1985) 771 F2d 695, 227 USPQ 464; In re Dike (CCPA 1968) 394 F2d 584, 157 USPQ 581; Tri-Wall Containers, Inc. v. U.S. (Ct Cls. 1969) 408 F2d 748, 161 USPQ 117; In re Brown et al. (CCPA 1972) 450 F2d 531, 173 USPQ 685; Ex parte Edwards et al (BPOAI 986) 231 USPQ 981.

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.121(b).

Claims 22-54 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

The required limitation for 100 to 450 ppm of the molybdenum level to the lubricating composition of claims 22 (and its dependent claims) and 53, and the required limitation for 750 to 7500 ppm of an oil soluble secondary diarylamine of claims 23 (and its dependent claims) and claim 53 is considered as new matter because the Letter Patent 5,650,381 issued on July 22, 1997 from the original application Serial No. 08/559,879 filed on November 20, 1995 provides for said components in said specific minimum and maximum proportions. Note the disclosure of about 750 ppm-5,000 ppm of diarylamine in Letter Patent 5,650,381 at column 6, lines 37-42. The

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subject matter of claim 51 that the lubricating composition further comprises at least one of the following additives: a dispersant, a detergent, and a zinc dihydrocarbyl dithiophosphate is not properly described in the application as filed and appears to be new matter. The disclosure in the paragraph bridging columns 6 and 7 provides for a fully formulated lubricant composition comprising between 75 and 95 wt. % of a mineral lubricant oil, between 0 and 10 wt. % of a polymeric viscosity index improver and between about 5 and 15 wt. % of an additive package consisting of (a) dispersant, (b) detergents and © ZDDP'S. Claim 52 step for" including" is considered as new matter because the instant application step for improving the antioxidant and friction properties of a lubricant comprises "adding" the molybdenum compound ...diarylamine. Claims 54 "A lubricated crankcase or transmission obtained according to claim 53" is considered as new matter because letter Patent 5,560,381 provide only for the "The compositions of this invention have various uses as lubricants such as automotive and truck crankcase lubricants as well as transmission lubricants" note letter Patent 5,650,381 at column 3, lines 9-11. There is no explicit disclosure for a lubricated crankcase or lubricated transmission.

The requirement of 37 CFR 1.178 (offer to surrender and return original patent) has not been met. See MPEP 1416.

The requirement of 37 CFR 3.73(b) (ownership and assignment) has not been satisfied, enclosed is form PTO/SB796 for statement under 37 CFR 3.73(b).



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The references cited and made of record in the letter Patent 5,650,381 have been reviewed and reconsidered. Copies of PTO 892 and PTO-1449 made of record in the letter Patent 5,650,381 are enclosed for Applicants' convenience.

The references cited in the parent application have been reviewed and reconsidered. The prior art cited but not applied further teach lubricant oil compositions comprising additives of the same nature as claimed by Applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday to Friday, from 7:30 A.M to 6:30 P. M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

November 19, 2001

Primary Examiner

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Margaret B. Medley

**MARGARET MEDLEY**  
**PRIMARY EXAMINER**  
*Margaret B. Medley*